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David C Jenkins
Eckert Seamans Cherin & Mellot LLC
600 Grant Street
44th Floor
Pittsburgh, PA 15219

EXAMINER

FISCHER, ANDREW J

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GANESH MANI

Appeal 2007-4045
Application 09/662,958
Technology Center 3600

Decided: March 19, 2008

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
ANTON W. FETTING, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ganesh Mani (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-70 and 90-93. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

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SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is to a method and system for transferring legal authority by electronic means to enable agents to perform services which may normally require execution of a power of attorney document to transfer such authority (Specification 1:8-11). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computer implemented method for a principal to electronically establish and use an agent, said method comprising the steps of:
 - (a) said principal identifying a service requirement;
 - (b) said principal submitting an electronic request for service;
 - (c) negotiating terms by principal and agent;
 - (d) establishing an electronic power of attorney;
and
 - (e) using an electronic device to verify said agent is performing said requested service.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Lloyd	US 4,876,648	Oct. 24, 1989
Walker	US 5,862,223	Jan. 19, 1999

The Appellant seeks our review of the Examiner's rejection of claims 1-70 and 90-93 under 35 U.S.C. § 103(a) as unpatentable over Walker and Lloyd.

ISSUE

The Appellant contends the Examiner erred in rejecting the claims because Lloyd's power of attorney is not established as an electronic document, and thus Lloyd fails to disclose an "electronic power of attorney" as claimed (App. Br. 5). The Appellant further argues that the rejection was improper because there is no suggestion that the cited references should be combined (*Id.*).

The Examiner found Lloyd's disclosure of converting a paper power of attorney form into electronic form so that it may be included as an attachment to an electronic notice satisfies the "establishing an electronic power of attorney" step in the claims (Ans. 9). The Examiner also concluded that "[i]ncluding a power of attorney in the system of Walker would have been obvious for the purpose of allowing experts or agents hired by principals to act on their behalf and render the services requested by those principals" (Ans. 10).

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting the pending claims as unpatentable over Walker and Lloyd. This issue turns on the meaning of "establishing an electronic power of attorney" as used in the claims.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Appellant's Specification states that "[t]he term 'electronic' with reference to document storage and transfer has its usual meaning and also encompasses other media such as optical or magnetic media" (Specification 4:27-29).
2. With reference to establishing an electronic power of attorney, the Appellant's Specification describes:

Referring again to Figure 1, once negotiations between principal and agent have been completed, the power of attorney document is generated in step 110. The form of the electronic power of attorney document can be any suitable form which clearly conveys the intent of the principal and agent to be bound by the terms and conditions placed on the performance of the particular service or services to be performed by the principal. It is preferred that the actual form of the power of attorney document be readily stored and retrieved by electrical, optic, magnetic or another similar conventional means. Alternatively, a hard copy of the electronic power of attorney "document" can be made available to the principal in the form of a confirmation copy mailed, e-mailed or faxed or transmitted by another suitable means for hard copy printing.

(Specification 13:9-19).

3. The Specification further notes that “[t]he power of attorney document can be ‘signed’ by a conventional means such as biometric fingerprint stamping or a digital signature” (Specification 13: 21-23).
4. The Specification provides an example in which “[t]he principal accepts the agent by clicking an ‘Accept Agent’ button that generates a digital signature corresponding to an electronic power of attorney document that is then generated” (Specification 24:9-11).
5. Claim 7, which depends from claim 1, further defines the step of “establishing an electronic power of attorney” to include the step of “electronically signing” a power of attorney document.

PRINCIPLES OF LAW

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill

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in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change). It is the appellant's burden to precisely define the invention, not the PTO's. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Appellants always have the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *Prater*, 415 F.2d at 1404-05.

We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) ("Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.") The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the

specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). Under the doctrine of claim differentiation, “the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc).

ANALYSIS

The Appellant argues claims 1-70 and 90-93 as a single group (App. Br. 4-5; Reply Br. 1-6). We select claim 1 as the representative claim, and the remaining claims stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellant contends the Examiner erred in rejecting the claims because Lloyd’s power of attorney is not established as an electronic document, and thus Lloyd fails to disclose “establishing an electronic power of attorney” as claimed (App. Br. 5). In particular, the Appellant argues that the phrase should not be interpreted so broadly as to include a paper power of attorney form that is converted into electronic form (e.g., scanned into a computer and generated as a pdf), because (1) “the addition of the word ‘electronic’ as an adjective clearly defines the new object or service as being different from the traditional object or service” and thus “electronic” clearly indicates that the service or communication exists in cyberspace and not in a physical form (Reply Br. 2-3); and (2) the claim requires “establishing” a

power of attorney, which relates to the creation of the principal/agent relationship over the communications medium and not on paper, because once a paper power of attorney has been signed, the principal/agent relationship has been established, and any subsequent conversion of that document to a digital format does nothing further to “establish” the relationship (Reply Br. 4). We are not persuaded by the Appellant’s arguments.

The Appellant’s Specification states that “[t]he term ‘electronic’ with reference to document storage and transfer has its usual meaning and also encompasses other media such as optical or magnetic media” (FF 1). This part of the Specification implies that the term “electronic” as used in the Specification and the claims refers to document storage and transfer. As such, we understand the step of “establishing an electronic power of attorney” to refer to the act of storing a power of attorney document on a computer for subsequent retrieval, display, and use via the computer.

Contrary to Appellant’s assertion (Reply Br. 2), this interpretation does not disassociate the word “electronic” from the phrase it modifies. An electronic power of attorney is one type of an electronic document. Establishing an electronic document consists of either creating the document in the computer or converting a hard copy of the document into machine readable form so that it can be stored on and used by the computer. The electronic power of attorney can be “established,” for example, by creating the document on the computer using electronic signature, or by creating a

pdf version of a signed hard copy of the document by scanning it into the computer. We decline to adopt the Appellant's narrower reading of step (d) which requires "establishing" to refer to the act of creating the attorney-client relationship. At best, it is unclear from a plain reading of step (d) in view of the Specification what is intended, and thus we opt for the broader and more inclusive interpretation. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

This broader interpretation of the language of step (d) is consistent with the Appellant's Specification. For instance, the Appellant's Specification describes:

The form of the electronic power of attorney document can be *any suitable form* which clearly conveys the intent of the principal and agent to be bound by the terms and conditions placed on the performance of the particular service or services to be performed by the principal. It is preferred that the actual form of the power of attorney document be readily stored and retrieved by electrical, optic, magnetic or another similar conventional means.

(FF 2) (emphasis added). Once again, the Specification focuses on the method of storing the power of attorney rather than the method of creation of the attorney-client relationship.

Although the Specification notes that "[t]he power of attorney document *can be* 'signed' by a conventional means such as biometric fingerprint stamping or a digital signature," the Appellant's use of permissive language supports our understanding that the Specification does

not require that the document be electronically signed or that the attorney-client relationship be established by electronic means (FF 3). The Specification also provides an example in which the attorney-client relationship is created electronically when the principal clicks on an “Accept Agent” button (FF 4); however, we will not read this example embodiment into the broad language of the claims. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

Based on our reading of the Specification, we conclude that one having ordinary skill in the art would understand the claimed step of “establishing an electronic power of attorney” to refer to the act of storing a power of attorney document in a computer system. Nothing in the Specification requires an electronic power of attorney to be established by electronic signature. The establishment of an electronic power of attorney by electronically signing a document is merely a preferred embodiment of the invention covered by certain dependent claims (FF 5) and thus “establishing an electronic power of attorney” as used in the independent claims is not limited to that embodiment.

The Examiner found, and the Appellant does not dispute (App. Br. 5), that Lloyd discloses “a power of attorney form that is converted into electronic form so that it may be included as an attachment to an electronic notice” (Ans. 9). As such, Lloyd discloses the step of “establishing an electronic power of attorney” as claimed.

The Appellant further argues that the rejection was improper because there is no suggestion that the cited references should be combined, and the Examiner has not provided any evidence that one skilled in the art would have been motivated to combine the references (App. Br. 5 and Reply Br. 6). Although it is important for the Examiner to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does, the Court's recent decision in *KSR* made clear that there is no requirement for an actual teaching, suggestion, or motivation in the references themselves to combine. *KSR*, 127 S.Ct. at 1741 ("Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the [teaching-suggestion-motivation] test is incompatible with our precedents."). The Court explained that "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

The Examiner found that Walker discloses a system wherein a user is requesting a service through a third party (Ans. 10). The Examiner further found that Lloyd's powers of attorney between a borrower and a service company allow the service company to act on the borrower's behalf (*Id.*). The Examiner concluded that "[i]ncluding a power of attorney in the system of Walker would have been obvious for the purpose of allowing experts or agents hired by principals to act on their behalf and render the services

requested by those principals” (Ans. 10). In particular, the Examiner pointed to the disclosure in Walker of a scenario in which a user submits a job request to an Exchange service and allows the Exchange service to select a bid that fulfills the job requirements, and thereby delegating authority to the Exchange to allow the Exchange to bind the user (Ans. 10-11). The Examiner concludes that such a scenario is just the type of situation in which a power of attorney is necessary, and thus it would have been obvious to one having ordinary skill in the art that the user may execute a power of attorney, as taught by Lloyd, in order to delegate authority to the Exchange (Ans. 11).

We find no error in this conclusion of obviousness. The Examiner provided an explanation of his reasoning with a rational underpinning to support the legal conclusion of obviousness. We agree that the use of Lloyd’s powers of attorney in Walker’s system to provide means for an agent hired by a principal to act on the principal’s behalf and render the services requested by the principal would have been a predictable variation of Walker’s system. *See KSR*, 127 S.Ct. at 1740 (“if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill”). Accordingly, we sustain the Examiner’s rejection.

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CONCLUSIONS OF LAW

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 1-70 and 90-93 under 35 U.S.C. § 103(a) as unpatentable over Walker and Lloyd.

DECISION

The decision of the Examiner to reject claims 1-70 and 90-93 is affirmed. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

vsh

DAVID C. JENKINS
ECKERT SEAMANS CHERIN & MELLOTT LLC
600 GRANT STREET
44TH FLOOR
PITTSBURGH PA 15219